

Applic. No. 09/894,674  
Amdt. dated November 25, 2005  
Reply to Office action of July 25, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-16 are now in the application. Claims 14-16 have been amended. Support for the changes to claim 16 can be found on page 13, lines 7-20

In item 2 on page 2 of the above-identified Office action, claims 14 and 15 have been rejected as failing to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

More specifically, the Examiner has stated that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to ...claimed invention. Applicant respectfully disagrees with the Examiner. The Examiner is directed to page 21, line 11 to page 22, line 3 of the specification of the instant application. This is the description of Fig. 3, which corresponds directly to claim 14. Therefore, the claims have not been amended to overcome the rejection. However, it is noted that claim 14 has been amended to remove the third optical sensor and has been made dependent on claim 10.

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It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, first paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

In item 4 on page 3 of the Office action, claims 1-3 and 7-9 have been rejected as being obvious over Loeffler (U.S. Patent No. 6,429,945 B1) in view of Ohigashi et al. (U.S. Patent No. 4,965,597) (hereinafter "Ohigashi") under 35 U.S.C. § 103.

In item 5 on page 6 of the Office action, claim 4 has been rejected as being obvious over Loeffler (U.S. Patent No. 6,429,945 B1) in view of Ohigashi (U.S. Patent No. 4,965,597) and further in view of Foote et al. (U.S. Patent No. 6,008,826) (hereinafter "Foote") under 35 U.S.C. § 103. Foote does not make up for the deficiencies of Loeffler and Ohigashi. Since claim 1 is believed to be allowable, dependent claim 4 is believed to be allowable as well.

In item 6 on page 8 of the Office action, claim 6 has been rejected as being obvious over Loeffler (U.S. Patent No. 6,429,945 B1) in view of Ohigashi (U.S. Patent No. 4,965,597) and further in view of deJong et al. (U.S. Patent No. 5,510,877) (hereinafter "deJong") under 35 U.S.C. § 103.

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deJong does not make up for the deficiencies of Loeffler and Ohigashi. Since claim 1 is believed to be allowable, dependent claim 6 is believed to be allowable as well.

In item 7 on page 9 of the Office action, claims 10, 12, 13, and 16 have been rejected as being obvious over Loeffler (U.S. Patent No. 6,429,945 B1) in view of Ohigashi (U.S. Patent No. 4,695,597) and Foote (U.S. Patent No. 6,008,826) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Applicant comments as follows in response to the Examiner's arguments on pages 13-14 of the Office action.

It is once again noted that the corporate assignee of the Loeffler reference is also the assignee of the instant application, therefore applicants are very familiar with the Loeffler reference.

The Loeffler reference discloses a device having an image pickup (12) in the form of a conventional video camera that is

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connected to an image scanner (23), which operates to scan the electrical image generated in the video camera of the printed image (i) on the sheet (11). However, the device disclosed by Loeffler, requires that the entire image and the entire paper sheet be detected in order to perform the calculation disclosed therein. However, in the present invention, such a solution is not possible due to the limited space available. Furthermore, the fact that the present invention pertains to a printing machine with transport cylinders where the sheet has a bent surface, makes it impossible to render a reception of the image as disclosed by Loeffler. Therefore, a person of ordinary skill in the art would not consider Loeffler nor would they be provided with any motivation to combine Loeffler and Ohigashi.

Moreover, it is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some

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teaching, suggestion or incentive supporting the combination".

In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original).

"Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Loeffler to incorporate the features of Ohigashi, and there is no teaching or suggestion in Ohigashi to incorporate the features of Loeffler.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the

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requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Loeffler or Ohigashi or to combine Loeffler's and Ohigashi's teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Loeffler or Ohigashi or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d

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1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Upon evaluation of the Examiner's comments, it is respectfully believed that the evidence adduced by the Examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the Examiner is requested to withdraw the rejection.

Since claims 1 and 10 are believed to be allowable dependent claims 2-4, 6-9, and 11-16 are believed to be allowable as well.

It is appreciatively noted that claim 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claims have not been amended as indicated by the Examiner, as the claims are believed to be patentable in their existing form.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 10. Claims 1 and 10 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 10, they are believed to be patentable as well.

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In view of the foregoing, reconsideration and allowance of claims 1-16 are solicited.

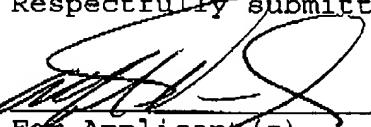
In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$120 in accordance with Section 1.17 is enclosed herewith.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &  
Greenberg P.A., No. 12-1099.

Respectfully submitted,  
  
For Applicant(s)

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AKD:cgm

November 25, 2005

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